

REMARKS

In view of the foregoing amendments and following remarks responsive to the Office Action dated September 21, 2006, Applicant respectfully requests favorable reconsideration of this application.

The Present Invention

The present invention is a portable electronic communication apparatus, such as a cellular telephone, comprising two housing portions, each having first and second opposing major surfaces. At least one surface includes a user interface, such as an LCD display. The device has at least three modes of operation, the particular current mode of operation being dictated by the positions of the two housings relative to each other as detected by a position detecting mechanism. The device comprises two housings rotatably connected to each other in such a way that permits the two housings to be positioned in at least three positions relative to each other, including an open position and two closed positions. Each housing includes a first surface and an opposing second surface. In a preferred embodiment, the two housings are connected by a pivot that permits the two housings to be aligned end to end in the open position, folded towards each other in a first closed position such that the second surface of the first housing is closed toward one surface of the other housing so that the user interface is accessible, and a second closed position such that the first surface of the first housing is closed toward one surface of the other housing so that the user interface is inaccessible. The pivot or other connecting

mechanism is adapted to detect which of the three positions the apparatus is in and automatically enter one of the three modes depending on which of the three positions it is in.

Rejection of claims 1, 2, 4-7, 9-14

The Office rejected claims 1, 2, 4-7, and 9-14 under 35 U.S.C. 103(a) as being unpatentable over Harris in view of Otsuka. The Office asserted that Harris discloses a portable electronic communication apparatus including a user-interface with at least three operational modes, first and second housing members, a user-interface on the first surface of the first housing member, and a connecting mechanism movably connecting the two housings, wherein the position of the first and second housing members relative to each other determines the mode of operation of the apparatus such that, when the first and second housing members are positioned together in the first closed position such that the second surface of the first housing member is closed toward one surface of the other member such that the user-interface is accessible, the apparatus is in a first mode operation of the user-interface, and when the first and second housing members are positioned together in a second closed position such that the first surface of the first member is closed toward one surface of the other member, the apparatus is in a second mode of operation of the user-interface.

The Office concedes, however, that Harris does not disclose when the first and second housing members are positioned together in the second close position

that the first surface of the first member is closed toward one surface of the other members such that the user-interface is inaccessible.

However, the Office cited Otsuka as disclosing when the first and second housing members are positioned together in a second closed position, the first surface of the first member is closed toward one surface of the other member such that the user-interface is inaccessible.

Finally, the Office asserted that it would have been obvious to modify Harris with the teachings of Otsuka "for the purpose of changing modes when it is in a closed position".

Applicant respectfully traverses.

MPE §2143 lists three requirements for a proper rejection based on obviousness, namely:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Contrary to the requirements of a proper obviousness rejection, the prior art of record does not provide any suggestion or motivation to combine these two references in the manner asserted by the Office. One of the fundamental concepts of the present invention is automatic entry into a particular operational mode based on the exposure or concealment (i.e., accessibility) of the user-interface, as determined by the relative positions of the two housing members. Accordingly, even when the device is in a closed position, the mode of operation depends on which

closed position it is in, and specifically, whether the user-interface is exposed or concealed in the particular closed position. In Harris, the two housing portions 108, 110 can rotate relative to each other about an axis perpendicular to the major surfaces thereof, i.e., perpendicular to the display user-interface that is on the front surface of housing 110 and to keypad, microphone, and speaker that are on the front surface of the other housing 108. Hence, in all of the possible positions of the first and second housings relative to each other in Harris, the various user-interfaces are always exposed. Accordingly, this fundamental concept of the present invention does not appear in Harris.

Likewise, while Otsuka teaches a folding phone where the user-interfaces can be concealed or exposed, it does not teach any mode dependence based on the position of the housings relative to each other.

Accordingly, neither of the references relied upon by the Office teach the fundamental concept of the present invention.

The prior art of record does not offer any other motivation for the proposed combination either. Examining the Office's asserted motivation, i.e., "for the purpose of changing modes when it is in a closed position", it is an improper alleged motivation. Neither reference actually provides such a motivation to the skilled artisan. Particularly, as noted above, neither reference teaches "changing modes when it is in a closed position" and therefore cannot possibly motivate the artisan "for the purpose of changing modes when it is in a closed position". Specifically, (1) Otsuka does not teach changing modes and (2) while Harris teaches changing

modes, none of those modes is a “closed” mode in which the user-interface is concealed (or “inaccessible” in accordance with the claim language) and, hence this issue is not even raised in Harris's device. Accordingly, the Office's asserted motivation does not exist in the prior art.

Claim 1 clearly recites this distinction because it recites that the different “closed” modes are a function of whether the first interface is accessible or inaccessible. Specifically, claim 1 recites “when the first and second housing members are connected and positioned together in a first closed position such that the second surface of the first housing member is closed toward one surface of the other housing member such that the user interface is accessible, the apparatus is in a first mode of operation of the user interface and when the first and second housing members are connected and positioned together in a second closed position such that the first surface of the first member is closed toward one surface of the other member such that the first user interface is inaccessible, the apparatus is in a second mode of operation of the user-interface”. Accordingly, claim 1 patentably distinguishes over the prior art of record.

Dependent claims 2, 4-7, and 9-14, which have been rejected based on the same combination of references, also distinguish over the prior art of record for at least all of the reasons set forth above with respect to claim 1, from which they depend.

Dependent claim 2 even further distinguishes over the prior art of record. Particularly, claim 2 adds that, when the first and second housing members are

connected and positioned apart from each other in an open position, the apparatus is in a third mode of operation of the user-interface in which the user-interface is active.

The Office cited Harris as teaching this feature. Particularly, the Office noted that, in Harris, column 2, lines 48-51, when the housings are detached, the device operates in another mode.

In claim 2, when the device is in the open position, the two housing members are still attached to each other. This is contrary to Harris, in which the Office's alleged "open" position involves the two housings being physically separated from each other. This is very different than Applicant's claim. Applicant has herein amended claims 1 and 2 to more clearly recite that all of these positions involve the two housings being connected to each other. Support for this amendment can be found at least in Figures 1, 2, and 3 of the specification.

Accordingly, claim 2 even further distinguishes over the prior art of record.

Even further, dependent claims 9, 10, and 11 add further recitations regarding the aspects of the particular modes of operation and how they relate to the exposure or concealment of the first user-interface. None of this is taught or suggested in the prior art of record.

Support for the amendment to claim 9 can be found at least in paragraph [0039] of the specification.

Dependent Claim 3

Dependent claim 3 also depends from claim 1 and has been rejected based on the above discussed combination of Harris and Otsuka and further in view of Kfoury. Claim 3 depends from claims 1 and 2 and adds that, "in the second mode of operation, the user-interface is inactive". The Office cited Kfoury as teaching that the user interface is inactive.

Regardless of whether Kfoury teaches that for which it has been cited, claim 3 is patentable over the prior art by virtue of its dependence on claims 1 and 2. Kfoury does not teach the teachings lacking from the Harris and Otsuka references discussed above in connection with claims 1 and 2. Specifically, due to the double swiveling action of the connecting member, Kfoury's device has six potential positions of the two housings relative to each other. This includes four closed positions and two open positions. However, column 6, lines 54-60 of Kfoury make clear that the position detector issues a single signal indicating that the device is closed whenever it is in any of the four closed positions. Accordingly, there is only one automatic mode of operation for all four closed positions. Hence, Kfoury also does not teach the aforementioned fundamental concept of the present invention noted above of automatically entering a mode based on whether a user interface is exposed or concealed such that, even when the device is in a closed position, the mode of operation depends on which closed position it is in, and specifically, whether the user-interface is exposed or concealed in the particular closed position.

Accordingly, claim 3 patentably distinguishes over the prior art of record for at least all of the same reasons set forth above with respect to claims 1 and 2.

Claims 17, 27, and 29

The Office rejected independent claim 17 and its dependent claims 27 and 29 as unpatentable over Otsuka in view of Harris. Particularly, the Office asserted that Otsuka discloses a portable communication device comprising a first and a second housing, each having a first surface and a second, opposing surface, the first housing including a first user-interface on the first surface, the device further comprising a pivot mechanism permitting pivoting between the houses including first and second closed positions and an open position as described in the claim. The Office conceded, however, that Otsuka fails to disclose that the device is in a first operational mode when in the first open position, in a second operational mode when in the first closed position, and in a third operational mode when in the second closed position, as well as means for automatically detecting when the device is in the various positions and automatically entering the corresponding mode responsive to the means for detecting.

However, the Office asserted that Harris discloses these features and that it would have been obvious to modify Otsuka to have these automatic operational modes depending on the position "for the purpose of detecting opening and closing of housing for mode change of apparatus".

The rejection of claim 17 is based on the same two references as the rejection of claim 1 discussed above. The same reasoning applied above in overcoming the rejection of claim 1 applies here. Particularly, there is no motivation, suggestion, or teaching in the prior art to make the proposed combination because neither of the references suggests the fundamental concept of the present invention of automatically entering a mode of operation depending on whether and how the user-interface is exposed or concealed.

Accordingly, the proposed combination is improper for all the same reasons set forth above in connection with claim 1.

In addition, Applicant has amended claim 17 similarly to claims 1 and 2 to make clearer that, in all three positions, the two housing members are connected together. Accordingly, the distinction, as discussed above in connection with claim 2 also applies to claim 17. Particularly, the Office relies on Harris as teaching a third position and a third mode by virtue of Harris's teaching of a condition in which the two housings are completely separated from each other. However, claim 17 recites that the housing members are connected in all of the recited positions.

Thus, the asserted prior art does not teach all of the limitations of claim 17 for each of the same reasons discussed above in connection with claims 1 and 2 above.

Claims 27 and 29 depend from claim 17 and therefore distinguish over the prior art of record for at least all the same reasons set forth above in connection with independent claim 17.

Claims 28 and 33-35

The Office rejected dependent claims 28, and 33-35 under 35 U.S.C. 103(a) as unpatentable over Otsuka in view of Harris as applied to claim 17 and 29 and further in view of Kfoury. The Office cited Kfoury as teaching the limitations added by these dependent claims. However, as previously noted above in the discussion of claim 3, Kfoury does not add the teachings lacking from the two primary references set forth above in connection with independent claim 17 from which these claims depend. Accordingly, claims 28 and 33-35 distinguish over the prior art of record for least all of the reasons set forth above in connection with claim 17.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. Applicant respectfully requests the Examiner to issue a Notice of Allowance at the earliest possible date. The Examiner is invited to contact Applicant's undersigned counsel by telephone call in order to further the prosecution of this case in any way.

Group Art Unit: 2681
Application No. 10/700,189

Docket No. Bennetts 2-5

The Commissioner is hereby authorized to charge any fees which may be required, any deficiencies that may arise, and to credit any overpayment which may be owed to Applicant in connection with this action and application in general to Deposit Account No. 19-5425.

Respectfully submitted,

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